



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/752,993

01/08/2004

Setsuo Nakajima

740756-2683

6484

22204

7590

06/19/2009

NIXON PEABODY, LLP

401 9TH STREET, NW

SUITE 900

WASHINGTON, DC 20004-2128

EXAMINER

RAO, SHRINIVAS H

ART UNIT

PAPER NUMBER

2814

MAIL DATE

DELIVERY MODE

06/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/752,993	Applicant(s) NAKAJIMA, SETSUO	
	Examiner STEVEN H. RAO	Art Unit 2814	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 1-4,6-10,12-16,18-22,24-26,,30-,34,36-54,.
 Claim(s) objected to: 92-98.
 Claim(s) rejected: 55-91.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☒ Other: See Continuation Sheet.

/Howard Weiss/
 Primary Examiner
 Art Unit 2814

Continuation of 3. NOTE: claim 101 newly added without cancelling any additional claim/s..

Continuation of 13. Other: No proposed amendments to the claims were proposed in the interview of April 20, 2009. However Applicants' stated they will file a RCE and an amendment therewith, instead they filed an amendment after final. Applicants arguments are not persuasive as they based on what the applied references individually (Nitta fails to teach, Sasaki does not allegedly teach or Mitnaga allegedly

Fails to teach whereas the rejection is based on combined teachings). Applicants' are taking bits and pieces of the applied references and arguing the references allegedly does not particular limitations, however the Applicants' are required to view the entire applied art.

It is noted for the record that the applied Nitta, Sasaki and Miyanaga teach all the presently recited Limitations as set out in the rejections. Applicants' arguments are not commensurate in scope with the presently recited claims as the claims recite neither the atmospheric conditions nor the laser power

. Required for the surface leveling. As applicants' claims do not recite the conditions (atmosphere and laser power) needed for allegedly irradiating the surface, these UN recited conditions cannot form the basis of distinguishing the claims over the prior art. Applicants' conclusion Sasaki's film would fail to control the thickness due to its alleged monatomic scale is not persuasive because Applicants' have not provided any evidence contradicting sasaki's teachings that states that surface roughens and thickness can be controlled. As also stated in rejection of claim 76, Sasaki in fig.1 and col. 2 lines 60-65describes supplying a gas one side of the substrate and floating the substrate over the stage by the gas as recited in claim 86.

Further Applicants' are again arguing piecemeal what Nitta teaches and what allegedly Miyanaga does not teach. It is noted that the teachings of one of the applied references need not be repeated by other references. Otherwise the outstanding rejection would be a 102 rejection and not a 103 rejection.

Therefore none of Applicants' arguments are persuasive and the claims 1-4,6-10,12-16,18-22,24-28,30,34,36-54,99 and 100 are rejected and presently newly added claim 101 is not entered.